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10/024,482	12/21/2001	Daniela Giacchetti	05725.1011-00	4566
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
BORISSOV, IGOR N				
ART UNIT		PAPER NUMBER		
3628				
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10/14/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/024,482

Applicant(s)

GIACCHETTI, DANIELA

Examiner

IGOR BORISSOV

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Response to Amendment

Amendment received on 07/12/2010 is acknowledged and entered. Claims 1-15 and 18-21 have previously been canceled. Claims 16 and 17 have been amended. Claims 16 and 17 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 16 recites (emphasis added):

displaying, on a display device, a plurality of templates, wherein at least some of the templates depict a portion of a face consisting of less than the entire face, the portion of the face having a simulation of use of a beauty product other than a scalp hair coloring product;

selecting at least one of the displayed templates; and

displaying, on the display device, a simulated facial image having a substantially complete face, including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion having a simulation of the simulated facial image corresponds to a facial portion of the at least one selected

template, and wherein the simulation of the displayed facial portion corresponds to a simulation of the at least one selected template.

Specification does not provide support for the underlined limitations. There is no indication in the Specification that the *scalp hair coloring product* is excluded from displaying.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1.

Claims 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Orpaz et al. (US 6,937,755) in view of Marapane et al. (WO 01/87245).

Claims 16 and 17.

Orpaz et al. (Orpaz) teaches a computer-implemented system, said system including a processor and a display, and a computer-readable medium containing instructions for causing the processor to implement a method for enabling display of a simulated facial image, wherein the method comprises:

facilitating display, on a display device, of a plurality of templates, wherein at least some of the templates are representative of a beauty product and a color option of said product to be applied to a portion of a face, said templates each having an associated appearance (a simulation of use) information for the product including a

three-bit RGB color representation and two 1 byte parameters for layer texture and light reflectivity (i.e., "glossiness") (C. 6, L. 61-63; C. 5, L. 7-15);

enabling selection of at least one of the displayed templates (C. 6, L. 61-63); and
facilitating display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion having a simulation of the simulated facial image corresponds to a facial portion of the at least one selected template, and wherein the simulation of the displayed facial portion corresponds to a simulation of the at least one selected template (C. 6, L. 63 - C. 7, L. 13).

Orpaz does not teach that said associated appearance (a simulation of use) information for the product is displayed simultaneously with said beauty product and a color option of said product.

Marapane et al. (Marapane) teaches a computer-implemented system and method for recommending hair color agents (a beauty product) for consumers, wherein a plurality of templates depicting a simulation of use of a beauty product is presented to the consumer so that the consumer can select a desired template and the final output - a simulated facial image of the consumer is presented on a screen (Figs. 9 and 15; p. 5, lines 14-17; p. 10, lines 5-6; p. 12, lines 13-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Orpaz to include displaying a simulation of use of the product information, as disclosed in Marapane, because it would advantageously allow to simplify the interface and facilitate the interaction process for the consumer. Alternatively, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Orpaz to include displaying a simulation of use of the product information, as disclosed in Marapane, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

As per limitation "other than a scalp hair coloring product", it would be a simply common sense to extend/substitute examples of beauty product disclosed in Marapane (hair coloring products) to other beauty products (lipstick, mascara, eye shadow, etc). In view on references discussed above, one of ordinary skill in the art would recognize what type of beauty products can be applied to a human face, and the art of applying beauty products such as lipstick, mascara, eye shadow, etc. is well known for the consumers.

Therefore, it would have been obvious to try, by one of ordinary skill in the art at the time of the invention, to modify the combination of Orpaz and Marapane to incorporate "other than a scalp hair coloring product" limitation, since there are a finite number of identified, predictable potential solutions (i.e., lipstick, mascara, eye shadow, etc) to the recognized need of looking good and one of ordinary skill in the art would have pursued the known potential solutions (cosmetic products) with a reasonable expectation of success. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

2.

Claims 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,937,755) Marapane et al. in view of Mase et al. (US 5,491,777).

Claims 16 and 17.

Marapane teaches:

facilitating display, on a display device, of a plurality of templates, wherein at least some of the templates are representative of a face having a simulation of use of a beauty product (Fig. 9; p. 5, lines 14-17);

enabling selection of at least one of the displayed templates (p. 5, lines 14-17);

facilitating display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion having a simulation of the simulated facial image

corresponds to a facial image of the at least one selected template, and wherein the simulation of the displayed facial image corresponds to a simulation of the at least one selected template (Fig. 15; p. 5, lines 14-17; p. 10, lines 5-6; p. 12, lines 13-15).

Marapane does not explicitly teach that said templates are representative of a portion of a face.

Mase et al. (Mase) teaches a computer-implemented system and method for image data processing, wherein a user is presented with a plurality of templates each template is a representative of a facial portion of a face (i.e., hair), and wherein, upon selection of a desired template, a simulated facial image is generated corresponding to the selected template (facial portion) (Figs. 3A, 34A, 37A-37C).

It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify Marapane to include that said templates are representative of a portion of a face, as disclosed in Mase, because it would advantageously allow to decrease image processing time, as specifically stated in Marapane. Alternatively, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Marapane to include that said templates are representative of a portion of a face, as disclosed in Mase, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

As per limitation "other than a scalp hair coloring product", it would be a simply common sense to extend/substitute examples of beauty product disclosed in Marapane (hair coloring products) to other beauty products (lipstick, mascara, eye shadow, etc). In view on references discussed above, one of ordinary skill in the art would recognize what type of beauty products can be applied to a human face, and the art of applying beauty products such as lipstick, mascara, eye shadow, etc. is well known for the consumers.

Therefore, it would have been obvious to try, by one of ordinary skill in the art at the time of the invention, to modify the combination of Orpaz and Mase to incorporate

"other than a scalp hair coloring product" limitation, since there are a finite number of identified, predictable potential solutions (i.e., lipstick, mascara, eye shadow, etc) to the recognized need of looking good and one of ordinary skill in the art would have pursued the known potential solutions (cosmetic products) with a reasonable expectation of success. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

3.

Claims 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Orpaz et al. in view of Marapane et al. and further in view of Mase et al.

Claims 16 and 17.

Orpaz teaches a computer-implemented system, said system including a processor and a display, and a computer-readable medium containing instructions for causing the processor to implement a method for enabling display of a simulated facial image, wherein the method comprises:

facilitating display, on a display device, of a plurality of templates, wherein at least some of the templates are representative of a beauty product and a color option of said product to be applied to a portion of a face, said templates each having an associated appearance (a simulation of use) information for the product including a three-bit RGB color representation and two 1 byte parameters for layer texture and light reflectivity (i.e., "glossiness") (C. 6, L. 61-63; C. 5, L. 7-15);

enabling selection of at least one of the displayed templates (C. 6, L. 61-63); and

facilitating display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion having a simulation of the simulated facial image corresponds to a facial portion of the at least one selected template, and wherein the simulation of the displayed facial portion corresponds to a simulation of the at least one selected template (C. 6, L. 63 - C. 7, L. 13).

Orpaz does not teach that said displaying said templates includes displaying said associated appearance (a simulation of use) information for the product.

Marapane teaches a computer-implemented system and method for recommending hair color agents (a beauty product) for consumers, wherein a plurality of templates depicting a simulation of use of a beauty product is presented to the consumer so that the consumer can select a desired template and the final output - a simulated facial image of the consumer is presented on a screen (Figs. 9 and 15; p. 5, lines 14-17; p. 10, lines 5-6; p. 12, lines 13-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Orpaz to include displaying a simulation of use of the product information, as disclosed in Marapane, because it would advantageously allow to simplify the interface and facilitate the interaction process for the consumer. Alternatively, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Orpaz to include displaying a simulation of use of the product information, as disclosed in Marapane, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

While Marapane teaches displaying a simulated use of a product, the combination of Orpaz and Marapane does not explicitly teach that said displayed templates are representative of a portion of a face

Mase teaches a computer-implemented system and method for image data processing, wherein a user is presented with a plurality of templates each template is a representative of a facial portion of a face, and, wherein, upon selection of a desired template, a simulated facial image is generated corresponding to the selected template (facial portion) (Figs. 3A, 34A, 37A-37C).

It would have been prima facie obvious to one having ordinary skill in the art at the time the invention was made to modify Orpaz and Marapane to include that said templates are representative of a portion of a face, as disclosed in Mase, because it

would advantageously allow to decrease image processing time, as specifically stated in Marapane. Alternatively, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Orpaz and Marapane to include that said templates are representative of a portion of a face, as disclosed in Mase, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

As per limitation "other than a scalp hair coloring product", it would be a simply common sense to extend/substitute examples of beauty product disclosed in Marapane (hair coloring products) to other beauty products (lipstick, mascara, eye shadow, etc). In view on references discussed above, one of ordinary skill in the art would recognize what type of beauty products can be applied to a human face, and the art of applying beauty products such as lipstick, mascara, eye shadow, etc. is well known for the consumers.

Therefore, it would have been obvious to try, by one of ordinary skill in the art at the time of the invention, to modify the combination of Orpaz, Marapane and Mase to incorporate "other than a scalp hair coloring product" limitation, since there are a finite number of identified, predictable potential solutions (i.e., lipstick, mascara, eye shadow, etc) to the recognized need of looking good and one of ordinary skill in the art would have pursued the known potential solutions (cosmetic products) with a reasonable expectation of success. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Response to Arguments

Applicant's arguments with respect to claims 16 and 17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/
Primary Examiner, Art Unit 3628
10/12/2010